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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

R04-09-4078

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on September 12, 2005Signature [Signature]Typed or printed name David KOGAN

Application Number

10/763,967

Filed

01/22/04

First Named Inventor

Zelman, Gary M.

Art Unit

2873

Examiner

Mai, Huy K.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 50,868
Registration number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

Signature

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September 12, 2005

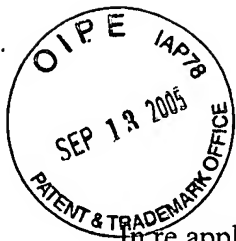
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
) Examiner: Mai, Huy K.
5 ZELMAN, GARY MARTIN)
)
) Art Unit: 2873
Serial Number: 10/763,967)
Filed: 01/22/04) Att. Docket No.: R04-09-4078
Title: Auxiliary Eyewear)
Attachment Methods and)
10 Apparatus)

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR A REVIEW

Mail Stop AF
15 Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

Sir/Madam:

Responsive to the Office Action of August 31, 2005, in which the Examiner made a final
20 rejection of the Applicant's claims, the Applicant is submitting a Request for a Pre-Appeal Brief
Review. A Request Form PTO SB/33 is submitted concurrently herewith. In complying with
the rules for the Panel Review Request, the Applicant respectfully submits the following reasons
why the Examiner's final rejection of the Applicant's claims is erroneous.

ARGUMENT

25 In the Office Action mailed August 31, 2005, the Examiner has made a final rejection of
Applicant's claims 15-28. The Applicant respectfully submits that all of the reasons listed in the
final rejection are clearly erroneous in view of the facts.

1. In the final rejection, the Examiner objected to the amendment of February 9, 2005,
under 35 U.S.C. 132(a) on the ground that "introduces new matter into the disclosure." See
30 08/31/05 OA, p. 2. Specifically, Examiner states, "[t]he added material which is not supported
by the original disclosure is as follows: said magnetic material **capable of fitting solely below**

(emphasized) and mating with magnetic material on said conventional eyeglasses.” *See Id.* This rejection is erroneous because in his new matter analysis, the Examiner focuses **only** on the “capable of fitting solely below” limitation and **ignores** the effect of the “such that said auxiliary eyeglasses are aligned with said conventional eyeglasses” limitation of the Applicant’s claims.

5 In fact, Figures 1 through 9 fully disclose and support **all** of the limitations added to Applicant’s claims in the latest amendments of June 20, 2005. Specifically, Figure 1 shows that there are appendages (18) formed on the auxiliary eyeglasses (10) and that **each one** of the appendages (18) contains magnetic material (26). Also, Figure 3 shows that the magnetic material (26) fits **only below** the magnetic material (30) and that no part of the magnetic material
10 (26) is above the magnetic material (30). Further, it can be seen in Figures 2 and 3 that the auxiliary eyeglasses (10) and the primary eyeglasses (20) **are aligned**.

 Looking at the Applicant’s drawing figures, it is clear that in order for the auxiliary eyeglasses (10) and the conventional eyeglasses (20) to be **properly aligned**, the magnetic material (26) **must be capable of fitting solely below** the magnetic material (30). It can be
15 easily realized from Figure 3 that if the magnetic material (26) is fitted **above** the magnetic material (30), the auxiliary eyeglasses (10) and the conventional eyeglasses (20) will **no longer be aligned**, making the invention inoperable. As such, Figure 3 clearly shows that the magnetic material (26) of the auxiliary eyeglasses (10) is capable of fitting **solely below** (and incapable of fitting above) the magnetic material (30) of the conventional eyeglasses (20) **such that the**
20 **auxiliary eyeglasses (10) are aligned with the conventional eyeglasses (20)**. Thus, Figure 3 clearly supports all of the claim limitations in claims 15-28.

 For this reason, the Applicant submits that the Applicant’s disclosure in Figures 1-9 adequately supports Applicant’s claims. The Examiner’s refusal to allow these claims is clearly

erroneous as seen by reading the full language of the claims and by referring to the specification and the drawings. The Applicant respectfully requests that the new matter rejection be withdrawn.

2. The Examiner has also rejected claims 15-26 under 35 U.S.C. 112, first paragraph, as

5 failing to comply with the written description requirement. Specifically, the Examiner stated,

the specification fails to support for the limitations ‘said magnetic material capable of fitting solely (emphasized) below and mating with magnetic material on said conventional eyeglasses’ now claimed in the independent claims 15, 24-26. **Nowhere in the specification provides support for such the limitations.**

10 *See* 08/31/05 OA, Page 2, ¶3 (emphasis added).

The Examiner is clearly erroneous in stating that the specification does not provide support for the “capable of fitting solely below” limitation. Again, the Examiner is ignoring the effect of
15 this claim limitation in view of the other limitations in the Applicant’s independent claims. In fact, the disputed limitation is plainly supported by Figures 1-9, as shown by the Applicant above in explaining that the new matter rejection is a result of erroneous reasoning by the Examiner.

In providing support for the 35 U.S.C. 112, ¶1 rejection, the Examiner stated,

20 [i]n fact the drawings, **particular Fig. 4, show that the magnetic material** on the auxiliary eyeglasses not only being ‘capable of fitting below’ but **also ‘capable of fitting above’** and mating with magnetic material on said conventional eyeglasses.

See 08/31/05 OA, Pages 2-3, ¶3 (emphasis added).

25 The Examiner is likewise erroneous that Figure 4 shows that the magnetic material on the auxiliary eyeglasses is “capable of fitting above” and mating with the magnetic material on the conventional eyeglasses “due to characteristics of magnetic attractive force.” Looking to Figure 4, it can be seen that the magnetic material (26) of the auxiliary eyeglasses (10) **fits below** and mates with the magnetic material (30) of the conventional eyeglasses (20). The thick arrow in

Figure 4 simply indicates that **the clip (42)** of the bridge (38) of the auxiliary eyeglasses (10) **fits on top of the bridge (44)** of the conventional eyeglasses (20). However, the clip (42), the bridge (38) and the bridge (44) **are not magnetic**, they are simply made of non-magnetic metal. Thus, in Figure 4, the magnetic material (26) of the auxiliary eyeglasses fits solely below the magnetic material (30) of the conventional eyeglasses.

Further looking to Figure 4, or to any one of the other eight figures, it can be seen that none of them show that the magnetic material is “capable of fitting above” such that the auxiliary eyeglasses are aligned with said conventional eyeglasses. In fact, if the magnetic material (26) of the auxiliary eyeglasses is fitted **above** the magnetic material (30) of the conventional eyeglasses, the auxiliary eyeglasses and the conventional eyeglasses **will not be aligned**, violating a limitation present in all of the independent claims in their current form.

In view of the above, the Figures in the Applicant’s specification provide support for the currently amended claims. As such, the Examiner’s 35 U.S.C. §112 rejection is clearly erroneous and the Applicant respectfully requests that this rejection be withdrawn.

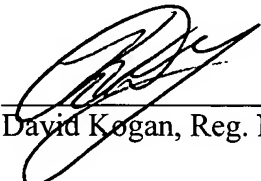
3. Finally, the Examiner rejected Claim 26 under U.S.C. § 103(a) as being unpatentable over *Chao*, U.S. Pat. No. 5,568,207. The Examiner stated that although claim 26 is a method claim, the method steps consist of the broad steps of “providing” and “mating” and therefore these steps would be inherently satisfied by the apparatus of the reference as modified. *See* 08/31/05 OA, p. 4. The Applicant respectfully submits that the Examiner is erroneous in asserting that the claims in their current form are obvious in view of *Chao*. The Applicant’s claims require that the magnetic material on the auxiliary glasses be **capable of fitting solely below** the magnetic material on the conventional glasses **such that said auxiliary eyeglasses**

are aligned with said conventional eyeglasses. Chao's patent does not disclose or suggest these claim limitations.

Chao teaches a **top-mounted** design, fitting magnetic material (22) of the auxiliary eyeglasses **above** the magnetic material (14) of the conventional glasses. Additionally, Chao specifically teaches that the primary advantage of his invention is that the metallic arm (21) of the auxiliary eyeglasses physically sits on top of the metallic arm (11) of the primary eyeglasses, thus stably engaging the two frames. See '207 patent, Col 1, ll. 55-65; Col. 2, ll. 47-57; Figs. 5 and 7. Applicant, on the other hand, does not fit the magnets of the auxiliary glasses above the magnets of the conventional glasses, but accomplishes the attachment via fitting the magnetic material of the auxiliary glasses solely below the magnetic material of the conventional glasses such that said auxiliary eyeglasses are aligned with said conventional eyeglasses.

If one were to attach Chao's magnetic members (22) on the arms (21) of the auxiliary eyeglasses **solely from below** the magnetic members (14) on the arms (11) of the conventional frame, **the auxiliary eyeglasses and the conventional eyeglasses will not be properly aligned and Chao's invention would be inoperable.** In order to avoid this misalignment, the Chao's invention **must always have magnetic material** (22) of the auxiliary eyeglasses **above** the magnetic material (14) of the conventional eyeglasses. This teaches away from rather than suggests the Applicant's invention. Thus, the Examiner's obviousness rejection of Applicant's claims over Chao is erroneous and should be withdrawn, along with the rest of the above-discussed rejections.

Respectfully submitted,
Trojan Law Offices


David Kogan, Reg. No. 50,868

Date: September 12, 2005